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EXAMINER

WASSUM, LUKE S

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/932,070
Filing Date: August 17, 2001
Appellant(s): BUIL ET AL.

Thomas Spinelli
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 17 March 2005.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

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(7) *Grouping of Claims*

Appellant's brief includes a statement that the claims do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,616,876	CLUTS	04-1997
5,969,283	LOONEY et al.	10-1999
2003/0229537	DUNNING et al.	12-2003

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5, 9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cluts** (U.S. Patent 5,616,876) in view of **Looney et al.** (U.S. Patent 5,969,283).

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cluts** (U.S. Patent 5,616,876) in view of **Looney et al.** (U.S. Patent 5,969,283) as applied to claims 1-5, 9 and 11-13 above, and further in view of **Dunning et al.** (U.S. Patent Application Publication 2003/0229537).

These rejections are set forth in a prior Office action, mailed on 19 October 2004.

The examiner further notes that claim 10 has been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (see Office action mailed 19 October 2004).

For the convenience of the Honorable Board of Appeals, a copy of the rejection of representative independent claims 1 and 11 are included herein.

Regarding claim 1, **Cluts** teaches a system for browsing a collection of information units as claimed, comprising presentation means for presenting at least one of said information units (see discussion of the ability to listen to songs, col. 4, lines 38-54), and attribute means for associating a respective one of said information units with an attribute value (see discussion of the classification of content, col. 14, lines 28-50), wherein the system comprises random selection means for randomly selecting a unit for presentation whose attribute value meets a criterion (see col. 18, lines 51-54).

Cluts does not explicitly teach a system wherein the system includes a random selection means for automatically selecting and presenting a unit without interaction by a user.

Looney et al., however, teaches a system wherein the system includes a random selection means for automatically selecting and presenting a unit without interaction by a user (see disclosure

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that music can be played back in random order, in the Abstract, also in col. 2, lines 5-18, also in col. 10, lines 49-57).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a randomization function as claimed, since such functionality is desirable to prevent the monotony of being presented the same songs in the same order, and further because such functionality has been well known and common in the art for many years, such as the randomize function on CD players.

Regarding claim 11, **Cluts** teaches a method of browsing a collection of information units as claimed, comprising a step of presenting an information unit from said collection (see discussion of the ability to listen to songs, col. 4, lines 38-54) and a step of associating a respective information unit with an attribute value for at least a first attribute (see discussion of the classification of content, col. 14, lines 28-50), wherein the method comprises a step of randomly selecting a unit for presentation from information units whose attribute values meet a criterion for said first attribute (see col. 18, lines 51-54).

Cluts does not explicitly teach a system wherein the system includes a random selection means for automatically selecting and presenting a unit without interaction by a user.

Looney et al., however, teaches a system wherein the system includes a random selection means for automatically selecting and presenting a unit without interaction by a user (see disclosure

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It would have been obvious to one of ordinary skill in the art at the time of the invention to include a randomization function as claimed, since such functionality is desirable to prevent the monotony of being presented the same songs in the same order, and further because such functionality has been well known and common in the art for many years, such as the randomize function on CD players.

(11) Response to Argument

This Examiner's answer will address the arguments in the order in which they appear in the appeal brief.

A. Issue 1

Claims 1-5, 9 and 11-13 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over CLUTS in view of LOONEY et al.

Regarding claims 1-5, 9 and 11-13, Appellant argues that (1) the Examiner's suggestion and motivation for the combination of the Cluts and Looney et al. references is improper and must be withdrawn (page 11, second paragraph of the Brief), that (2) one of the references must teach or suggest that it can be combined with the other (page 15, last paragraph), that (3) the inventors'

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reason for implementing the claimed randomization feature differs from the motivation provided by the examiner to support incorporation of the feature (page 16, middle paragraph), that (4) the fact that randomization functionality has been well known and common in the art for many years, such as the randomization function in CD players, is irrelevant in an obviousness analysis (page 16, last paragraph and page 17, first paragraph), and finally that (5) the examiner has used impermissible hindsight in combining the references in order to reject the claims.

In response, the examiner presents the following arguments.

Regarding argument (1) [that the Examiner's suggestion and motivation for the combination of the **Cluts** and **Looney et al.** references is improper and must be withdrawn], the examiner respectfully responds that the motivation to combine the references is proper, for the following reasons.

Initially, the examiner points out that the bulk of the case law cited by the Appellants in support of their allegation of lack of motivation has no bearing on the case at hand. In many of these cases, discrete elements from references of different fields of endeavor were being combined to make a rejection. In this case, the references are from the same field of endeavor, that is, the retrieval and rendering of information, such as music, to a user.

The examiner draws attention to MPEP § 2143.01[R-2]:

"There are three possible sources for a motivation to combine references: the nature of

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the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

In this case, both references (**Cluts** and **Looney et al.**) disclose systems which select and render musical selections based upon criteria input by the user. The fact that the disclosed musical selections are analogous to the claimed 'information units' is made plain by the Appellants' specification at page 1, lines 11-22, wherein it is explicitly disclosed in the Background of the Invention that the invention is drawn towards a system wherein compressed music files can be stored either locally or on a remote server and accessed by a user (in at least one embodiment).

The **Cluts** reference teaches a system wherein a user can select music to be listened to on the basis of subjective content. The **Looney et al.** reference teaches a system for selecting musical selections based on user-entered criteria, and then automatically randomizing the musical selections that comply with the user-entered criteria to provide "disc-jockey" type playback (see col. 9, lines 34-59).

The motivation to combine the references stems from the fact that both references teach systems for providing music based upon user-selected criteria (thus establishing the fact that they are of the same field of endeavor and attempt to address the same problem, that is, retrieval and

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rendering of musical selections that are desirable to a user) and the desirability of a randomized playback of the selected musical selections.

Given that the references both address the same problem, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate advantageous features from one reference into the invention disclosed in the other reference. The examiner contends that the advantages of random (as opposed to in-order) playback of musical selections, and the ubiquitousness of randomized playback features in music-rendering systems (as stated in the rejection of record) renders the invention obvious in view of the cited prior art. The ubiquitousness of randomized playback supports the examiner's contention that such a feature is desirable, and that therefore an ordinary artisan would have ample motivation to incorporate such a feature in a music-rendering system.

Regarding argument (2) [that one of the references must teach or suggest that it can be combined with the other], the examiner respectfully refers the Appellants to the MPEP, disclosing the fact that there are three possible sources for motivation to combine, and that contrary to the allegation of the Appellants, motivation need not be derived solely from the references themselves (*supra*).

Regarding argument (3) [that the inventors' reason for implementing the claimed randomization feature differs from the motivation provided by the examiner to support

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incorporation of the feature], the examiner respectfully responds that the objective of the present invention is irrelevant to the issue of determining a proper motivation to combine the references of record. The two references cited by the examiner in the rejection of record, when combined, contain all of the claimed limitations, and the motivation to combine the references is proper.

Furthermore, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Regarding argument (4) [that the fact that randomization functionality has been well known and common in the art for many years, such as the randomization function in CD players, is irrelevant in an obviousness analysis], the examiner respectfully responds that, as discussed above, the ubiquitousness of a randomization feature in music rendering devices is clear evidence of the desirability of the feature. Given this desirability, it would have been obvious to an ordinary artisan to incorporate such a feature into a music rendering system.

Regarding argument (5) [that the examiner has used impermissible hindsight in combining the references in order to reject the claims], the examiner respectfully responds that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge

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gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Furthermore, in the examiner's above response to argument (1), the examiner has presented ample evidence and reasoning as to why the motivation to combine the references is proper.

For these reasons, the Examiner maintains that the rejection of claims 1-5, 9 and 11-13 is proper, and should be sustained.

B. Issue 2

Claims 6-8 are properly rejected under 35 U.S.C. § 103(a) over CLUTS in view of LOONEY et al. in view of DUNNING et al.

Regarding claims 6-8, Appellants argue that the claims, being dependent upon claim 1, are allowable.

In response, the examiner refers to the arguments presented in response to the Appellant's argument regarding the rejection of claim 1 (*supra*).

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For these reasons, the Examiner maintains that the rejection of claims 6-8 is proper, and should be sustained.

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Conclusion

Claims 1-9 and 11-13 are properly rejected under 35 U.S.C. §103(a).

In light of the foregoing arguments, the Examiner respectfully requests the Honorable Board of Appeals to sustain the rejections.

For the above reasons, it is believed that the rejections should be sustained.

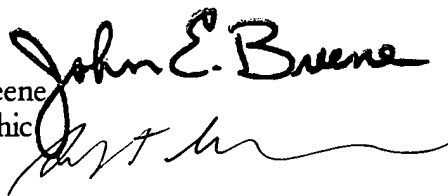
Respectfully submitted,



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April 21, 2005

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